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10-24-01
INPatent
Attorney's Docket No. 030662-066

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Keiko NERIISHI et al.)
Application No.: 09/749,410) Group Art Unit: 1655
Filed: December 28, 2000) Examiner: A. Chakrabarti
For: DNA DETECTION DEVICE)

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REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Official Communication mailed on September 21, 2001, requiring restriction pursuant to 35 U.S.C. § 121, applicants hereby elect with traverse to prosecute Group I, claims 1-3, drawn to a process for detecting a complementary DNA fragment.¹

The process for detecting a complementary DNA fragment as described in claims 1-3 (Group I) utilizes a DNA micro-array, a radiation image storage panel and a spacer

¹ To clarify the record, applicants wish to point out that the telephone call to the undersigned attorney described on page 3 of the Official Communication did in fact result in an oral election being made. More specifically, on August 20, 2001, the undersigned attorney spoke with Examiner Chakrabarti via telephone whereby the restriction requirement was set forth. On August 23, 2001, the undersigned attorney spoke with Examiner Chakrabarti once again whereby an election was made to prosecute Group I. Upon receipt of the written restriction requirement, the undersigned attorney immediately contacted Examiner Chakrabarti since applicants had already elected Group I. Examiner Chakrabarti apologized for the confusion and requested that applicants still respond to the written restriction requirement since it had already been mailed.

sheet. These components are also present in the kit and composite structure of claims 4-6. Further, claim 7 is directed to the radiation image storage panel which is set forth in claims 1-3. Thus, there is clearly a close relationship between the subject matter of Group I and Group II. In light of this close relationship, a search directed to the claims of Group I would almost necessarily include a search directed to the subject matter of the claims of Group II. In fact, such a search would be overlapping if not co-extensive.

Moreover, according to Section 803 of the M.P.E.P., a restriction between patentably distinct inventions is proper only where there is a serious burden on the Examiner to examine all the claims in a single application. This is true even when appropriate reasons exist for a restriction requirement. While applicants disagree that claims 1-3 (Group I) and claims 4-7 (Group II) are patentably distinct, at the very least there would not be a serious burden on the Examiner to examine all of the claims in the subject application at the same time.

In view of the above, withdrawal of the requirement for restriction is respectfully requested and believed to be in order.

Favorable consideration on the merits of all the claims of record is respectfully requested.

In the event that there are any questions relating to this Reply to Restriction Requirement, or the application in general, it would be appreciated if the Examiner would

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telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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